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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 09/965,914
Filing Date: September 28, 2001
Appellant(s): O'CONNELL ET AL.

John L. Adair
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed on 12/22/2006 appealing from the Office action mailed on 04/11/2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,591,266	Li et al.	07/2003
6,697,849	Carlson	02/2004

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

1. Claims 1-61 are presented for examination.

2. The declaration refiled on 02/23/2006 under 37 CFR 1.131 has been considered but is ineffective to overcome the Li et al. patent no. 6,591,266 reference.

3. The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Li et al. reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897). Exhibits A and B do not explicitly prove, demonstrate, nor clearly show in

details how the claimed invention can be constructed using information from the email and the outline in the Exhibits A and B.

The affidavit or declaration and exhibits must clearly explain which facts or data applicant is relying on to show completion of his or her invention prior to the particular date. Vague and general statements in broad terms about what the exhibits describe along with a general assertion that the exhibits describe a reduction to practice "amounts essentially to mere pleading, unsupported by proof or a showing of facts" and, thus, does not satisfy the requirements of 37 CFR 1.131(b). In re Borkowski, 505 F.2d 713, 184 USPQ 29 (CCPA 1974). Applicant must give a clear explanation of the exhibits pointing out exactly what facts are established and relied on by applicant. 505 F.2d at 718-19, 184 USPQ at 33. See also In re Harry, 333 F.2d 920, 142 USPQ 164 (CCPA 1964) (Affidavit "asserts that facts exist but does not tell what they are or when they occurred.").

The question of sufficiency of affidavits or declarations under 37 CFR 1.131 should be reviewed and decided by a primary examiner. Examiner has reviewed the evidence submitted, and decided that the evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Li et al. reference as discussed above.

4. Examiner maintains the rejection as set forth in the last office action.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 1-61 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over Li et al. (Li) patent no. 6,591,266, in view of Carlson patent no. 6,697,849.

7. As to claim 1, Li teaches the invention substantially as claimed, including a method for cache management and regeneration of dynamically-generated content ("DGC") in one or more server computers within a client-server computer network, comprising the steps of:

in response to regeneration event, identifying a set of one or more previously cached DGC components affected by said regeneration event (Abstract; col. 7 lines 25-31; col. 8 line 54 - col. 9 line 17);

regenerating a new version of each affected DGC component in said set (col. 8 line 54 - col. 9 line 17); and

replacing each affected DGC component in said set with said respective new version of each (col. 8 line 54 - col. 9 line 17).

However, Li does not explicitly teach incorporating a criteria associated with said regeneration event.

Carlson teaches using tags to set caching criteria associated with a dynamic generated web pages event (col. 25 line 11 - col. 27 line 67).

It would have been obvious to one of ordinary skill in the Data Processing art at the time of the invention to combine the teachings of Li and Carlson to incorporate a criteria associated with said regeneration event because it would enhance system performance.

8. As to claims 2-3, Li teaches serving said new version of one or more of said affected DGC components in the form of a dynamically-generated page to a client computer in said client-server network in response to a request from said client computer (col. 7 lines 35-54; col. 9 lines 43-64).

9. As to claims 4-6, Li and Carlson teach identifying which of said affected DGC components satisfy a threshold criteria; said set of affected DGC components comprises only those affected DGC components that satisfy said threshold criteria; and said replacing step further comprises flushing those of said affected previously cached DGC components that do not satisfy said threshold criteria; wherein said threshold criteria is an arbitrary value of an arbitrary parameter; wherein said arbitrary parameter is an elapsed time since that last client computer request for a DGC component or for a dynamically-generated page (Li, col. 8 line 54 - col. 9 line 17; Carlson, col. 25 line 11 - col. 27 line 67; col. 30 lines 13-60).

10. As to claims 7-10, Li and Carlson teach any one or more of said identifying, regenerating and replacing steps can be performed at a different one of said one or more server computers from each other; limiting to a preset threshold value the number

of affected DGC component regenerations that can simultaneously occur; said preset threshold value is arbitrarily determined according a desired network performance level; said preset threshold value is determined by a static descriptor, such as a configuration variable (Li, col. 5 lines 28-39; Carlson, col. 13 line 22 - col. 14 line 6; col. 25 line 11 - col. 27 line 67; col. 30 lines 13-60).

11. As to claims 11-14, Li and Carlson teach said regeneration event comprises a change to a page template, an explicit flushing event, or a change to a DGC component; said explicit flushing event comprises the expiration of a preset time period; said criteria associated with said regeneration event is a change to a page template from which one or more previously cached dynamically-generated pages ("DGPs") were generated; said criteria associated with said regeneration event is a change to the content of one or more of said. previously cached DGC components, or no criteria (Li, col. 8 line 54 - col. 9 line 17; Carlson, col. 25 line 11 - col. 27 line 67, col. 30 lines 13-60).

12. As to claims 15-22, Li and Carlson teach every cached DGC component is associated with a custom cached file name comprising a combination of an initial file request name with a selected attribute of a computer user; said selected attribute is selected from the group including browser name, user language, computer domain, computer platform, and content ID; said selected attribute is a default attribute; said default attribute is no user attribute; said selected attribute is used in said regenerating step to regenerate said new versions of said affected DGC components; said selected

attribute is keyed to a particular application; updating a docroot file system to indicate changes resulting from replacing said affected DGC components; docroot file system is associated with a memory-based cache repository or a file-based cache repository (Li, col. 7 line 33 - col. 20 line 6; col. 23 lines 50; Carlson, col. 25 line 11 - col. 27 line 67, col. 30 line 13-60).

13. Claims 23-61 have similar limitations as claims 1-22; therefore, they are rejected under the same rationale.

(10) Response to Arguments

(A) Applicant argues that Examiner fails to consider the merits of the Declaration with respect to conception.

As to point (A), Examiner stated in Office Action mailed on 04/11/2006 that

> **The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Li et al. reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897). Exhibits A and B do not explicitly prove, demonstrate, nor clearly show in details how the claimed invention can be constructed using information from the email and the outline in the Exhibits A and B.**
>
> The affidavit or declaration and exhibits must clearly explain which facts or data applicant is relying on to show completion of his or her invention prior to the particular date. Vague and general statements in broad terms about what the exhibits describe along with a general assertion that the exhibits describe a reduction to practice "amounts essentially to mere pleading, unsupported by proof or a showing of facts" and, thus, does not satisfy the requirements of 37 CFR 1.131(b). In re Borkowski, 505 F.2d 713, 184 USPQ 29 (CCPA 1974). Applicant must give a clear explanation of the exhibits pointing out exactly what facts are established and relied on by applicant. 505 F.2d at 718-19, 184 USPQ

at 33. See also In re Harry, 333 F.2d 920, 142 USPQ 164 (CCPA 1964) (Affidavit "asserts that facts exist but does not tell what they are or when they occurred.").

The question of sufficiency of affidavits or declarations under 37 CFR 1.131 should be reviewed and decided by a primary examiner. Examiner has reviewed the evidence submitted, and decided that the evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Li et al. reference as discussed above.

Examiner has reviewed Exhibits A and B submitted by applicant; the Exhibits do not provide sufficient evidence to establish a conception of the invention prior to the effective date of the Li et al. reference as stated above.

However, if applicant can provide an explanation of the subject matter defined in each of the independent claims 1, 23, and 43 by clearly referring to the exhibits A and B by page and line numbers, Examiner will consider the exhibits provide sufficient evidence to establish a conception of the invention prior to the effective date of the Li et al. reference. Otherwise, it is clearly that the exhibits are merely vague ideas of how to solve a problem, but they are not sufficient to establish a conception of the invention.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

LE HIEN LUU
PRIMARY EXAMINER

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